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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,919	04/12/2007	Jan Hall	NOBELB.243NP	9222
29995 7590 07/28/2009 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER				
MAL HAOD				
ART UNIT		PAPER NUMBER		
3732				
NOTIFICATION DATE		DELIVERY MODE		
07/28/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary

Application No.

10/582,919

Applicant(s)

HALL, JAN

Examiner

HAO D. MAI

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 03/06/07; 06/17/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 4 and 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 4 recites a depth range "of between about 50-100" but fails to recite a unit, e.g. micrometer, millimeter, etc.
- Claim 4 recites the phrase "for example", which renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
- Claim 10 recites the limitation "the outer/upper portion", which lacks antecedent basis.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-3 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Baumgartner et al. (WO 01/49199 A2).**

Baumgartner et al. disclose a dental implant (Fig. 3B) capable for insertion into a hole formed in jawbone and overlying soft tissue, the dental implant comprising: a portion 11 to be placed against an upper edge of the jaw bone, wherein along at least most of its peripheral

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extent the portion is provided with at least one groove 13 configured to stimulate bone movement and bone ingrowth (Fig. 3B). Through said bone ingrowth, the implant is capable of forming a barrier against substantial or visible subsidence, around the portion, of the bone with overlying soft tissue.

As to claims 2-3, the implant comprises at least two parallel grooves 13 capable of being placed against the upper edge of the jaw bone; wherein each groove is arc-shaped, capable of following a corresponding arc-shaped jaw bone. As to claims 7-8, the ingrowth of bone into said grooves is capable of preventing visible exposure of the grooves; said ingrowth is also capable of preventing bacteria and/or organism from passing down from the upper parts of the dental implant to the underlying parts of the dental implant. As to claims 9-10, the groove 13 as shown extends all round the dental implant and extends substantially at a right angle to the longitudinal axis of the implant; wherein said groove 13 of the portion 11 is coordinated with grooves 13 on another portion, e.g. portion 10 (Fig. 3B).

Note that such claim language "configured to stimulate bone movement and bone ingrowth and through said ingrowth form a barrier" (claim 1), "configured to be placed against the upper edge of the jaw bone" (claim 2), "prevents visible exposure" (claim 7), etc., are functional language or intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). If the prior art structure is capable of performing the intended use, then it meets the claim. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed.Cir. 1997). *See also MPEP 2111.04 and 2114*. In this instant case, the implant as disclosed by Baumgartner et al. has all the claimed structures and is capable of performing such recited functions.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 4-5 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgartner et al. (WO 01/49199 A2).**

Baumgartner et al. disclose the invention substantially as claimed including the groove 13 having a cup-shaped cross section that is semi-circular shape, hyperbola shape, or semi-elliptical shape. However, Baumgartner et al. are silent to the specific measurements of the depth and width of said cup-shaped cross section. Nonetheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the groove's cup-shaped cross section having a depth and width with such range of measurements or values, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges and/or optimum value of result effective variable involves only routine skill in the art. *In re Aller*, 105 USPQ 233. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Any inquiry concerning this communication and earlier communication from the examiner should be directed to HAO D. MAI whose telephone number is 571-272-4709. The examiner can normally be reached on Monday-Friday. If attempts to reach the examiner by

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telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached at 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hao D Mai/

Examiner, Art Unit 3732

/Cris L. Rodriguez/

Supervisory Patent Examiner, Art Unit 3732